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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/486,977	03/06/2000	MARK HANS EMANUEL		6804

7590 09/07/2005  
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EXAMINER

BUI, VY Q

ART UNIT PAPER NUMBER

3731

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/486,977

Applicant(s)

EMANUEL, MARK HANS

Examiner

Vy Q. Bui

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 20-67 is/are pending in the application.
- 4a) Of the above claim(s) 24-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-23 and 38-67 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Specification***

The specification/amendment is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. It is not clear if the specification has support for the tube to receive an endoscope as recited in claims 44-45 and 54-55. Clarification is required.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 102***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 20-21, 38, 59, 61 are rejected under 35 U.S.C. 102(b) as being anticipated by KAGAWA et al (5,163,433).

As to claims 20-21, 38, 59, 61, KAGAWA discloses a cutting device 3 for removal of tissue from a body cavity in a human being (column 1, lines 11-16) including device 3 to end 15 which defines a first suction passage/first path 21 for discharging fluid with detached tissue, an outer tube 22b, an inner tube 22a, fluid pump 42 and suction pump 41. Probe 3 and inner tube 22a define fluid supply passage 25, inner tube 22a and outer tube 22b defines fluid passage 26/second path for discharging substantially only fluid because the suction mouth of the discharge passage 26 is next to the supply mouth of the supply passage 25 (see Fig. 1).

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Notice that first path and second path as indicated above are separate and first and second source of suction is the suction pump 41. Further, to avoid over flow of the body cavity, the fluid supplied from passage 25 and fluid discharged through passages 21 and 26 must be regulated so as to keep a balance between inflow fluid from passage 25 and outflow fluid through passages 25 and 26. Therefore, the pressure in the cavity body would be substantially constant.

KAGAWA device inherently discloses a method of discharging fluid with detached tissue through a first path (passage 21 as indicated above) and discharging substantially only fluid along a second path (passage 26 as indicated above) so as to regulate the pressure in the body cavity to remain substantially constant. Alternately, to avoid over flow of fluid from the body cavity, it would have been obvious to one of ordinary skill in the art at the time of the invention to regulate the KAGAWA device a in a method as recited in the claims such that the inflow fluid from passage 25 into the body cavity and the discharge fluid through passages 25, 26 out of the body cavity are maintained substantially the same and such that a pressure in the body cavity is maintained substantially constant as well.

Notice that according to the American Heritage Dictionary of the English Language, 3<sup>rd</sup> edition, "motor is a device that converts any form of energy into mechanical energy". Therefore, KAGAWA device 3 can be considered as **being motor driven** as recited in claim 20 because KAGAWA device 3 is a device that receives electrical energy via motor/piezoelectric elements (10a, 10b) to convert into mechanical energy (ultra-sonic vibration of device 3) by coupling to the other parts of the device (KAGAWA: col.5, lines 21-34).

3. Claims 39-42, 46-52, 56, 62 and 65 are rejected under 35 U.S.C. 102(b) as being anticipate by Bacich et al. (US Pat. 5,749,889).

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As to claims 39-42, 46-52, 56, 62 and 65, Bacich (Fig. 1-6, for example) discloses endoscope 104, cutter 112 for cutting a tissue in a body cavity/distensible organ, inflow conduit 106, outflow conduit 108, valve 166 and valve 168 in endoscope 104 for introducing fluid into the organ or for discharging fluid out of the organ.

***Claim Rejections - 35 USC § 103***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over KAGAWA et al (5,163,433).

As to claims 22 and 23, KAGAWA inherently discloses or alternatively suggests a method as recited in the claims, except for using an insertion mandrel for insertion into the body cavity before inserting the device. It is well known in the art to use a mandrel or a trocar to create an access passage to a body cavity before inserting a probe or a cutting device into the body cavity via the access passage. For example, BIRTCHE (WO 93/07821; line 27, page 1 to line 19, page 2) discloses such a standard laparoscopic procedure before inserting a probe or a cutting device into a body cavity. It would have been obvious to one of ordinary skill in the art at the time the invention was made to insert a mandrel or trocar into a body cavity to create an access passage and remove the trocar before inserting a probe or cutting device into the body cavity as this is a conventional laparoscopic procedure.

3. Claims 43 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bacich et al. (US Pat. 5,749,889) in view of Obenchain (US Pat. 5,195,541).

As to claims 43 and 53, Bacich et al. (US Pat. 5,749,889) discloses substantially the claimed invention, except for the cutter has a suction source to discharge fluid and cut tissue. However, a cutter having a channel for discharging fluid and cut tissue is well known. For example, Obenchain-'541 (Fig. 5) discloses a cutter/shaver 66 having a suction source. It would have been obvious to one of ordinary skill in the art at the time the invention was made to

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insert such a cutter/shaver through a lumen of an endoscope to cut tissue and discharge fluid with tissue through the cutter.

4. Claims 44-45 and 54-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bacich et al. (US Pat. 5,749,889) in view of Kimura et al. (US Pat. 5,695,448).

Bacich -'889 discloses substantially the claimed invention, except for a tube defining a lumen for receiving the endoscope. However, providing a tube/sheath for receiving an endoscope is well known in the art. For example, Kimura-'448 discloses tube/sheath 2 for covering/protecting endoscope 10 (Fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a tube/sheath to receive an endoscope during a surgical procedure so as the one can cover/protect the endoscope.

5. Claims 6-643 and 66-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bacich et al. (US Pat. 5,749,889).

Bacich-'889 discloses substantially the claimed invention including a video camera (column 19, lines 32-34) so that the physician can see the surgical site. It would be obvious to one of ordinary skill in the art at the time the invention was made to provide a lens and a camera as recited in the claims so that a physician can see the surgical site during the operation.

6. Claims 57-58 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Obenchain (US Pat. 5,195,541).

Obenchain-'541 discloses substantially the claimed invention, including a well-known rotating-motor driven shaver 66. Obenchain-'541 does not disclose a valve of an endoscope. However, providing a valve in an endoscope to prevent an uncontrolled loss/escaping of a fluid in a body cavity during a medical operation is well known in the art. It would be obvious to one of ordinary skill in the art at the time the invention was made to provide valve as recited in the claim so as one can prevent an uncontrolled loss/escaping of a fluid in a body cavity during a medical operation.

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***Response to Amendment***


The amendment filed on 3/21/2005 under 37 CFR 1.131 has been carefully considered but is moot in view of new rejection above.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vy Q. Bui whose telephone number is 571-272-4692. The examiner can normally be reached on Monday-Tuesday and Thursday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
09/02/2005

Vy Q. Bui  
Primary Examiner  
Art Unit 3731